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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,571	12/21/2005	Meng Hsin Chen	21406YP	5907
210 7590 09/29/2008 MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907				
EXAMINER BALASUBRAMANIAN, VENKATARAMAN				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
09/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ADVISORY ACTION

The applicants' response, which included cancellation of claims 1, 3-6, 8, 9 and 12-15 and addition of new claims 16-26, filed 7/9/2008 under 37 CFR 1.116 in reply to the final rejection is not entered as it is not deemed to place the application in condition for allowance for the following reasons.

Claim Rejections - 35 USC § 112

Claims 18-20 will be rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. The newly added claims 18-20 are improper dependent claims as they fail to further limit claim 16 on which they are dependent. Compare W choice of claim 16 with the W choice of claim 18. Note the n value of claim 18 mismatches with that of claim 16.
2. Claim 19 is indefinite as it recites Q choice as Ry. Thus the scope Q is different from that of claim 16 on which claim 19 is dependent.

Applicants did not overcome the following 102 rejection made in the previous office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-6, 8 and 12-15 are rejected under 35 U.S.C. 102 (b) as being anticipated by Yamasaki et al., US 6,352,985.

Yamasaki et al. teaches several benzimidazole compounds for treating glaucoma, which include those claimed in the instant claims. See column 2, formula I and note the definition of R₁, R₂, R₃, and R₄ groups. Note with the given definition of these variable groups compounds taught by Yamasaki et al., include instant compounds. See column 2-19 for preferred embodiments and process of making these compounds. See column 29-39 and figure 1-58 for various species made. See also column 41-162 for examples 1-322.

This rejection is same as made in the previous office action. Applicants' amendment to R₄ and R₅ did not completely exclude compounds taught in this reference. Note cyano-benzimidazole is taught in this reference which is also embraced in the instant claims. See compound 52. In addition when R₄ or R₅ is substituted alkyl, the compounds taught by the reference are also claimed in the instant claims. See compounds 160-162.

Also see definition of R₃ and R₄ choices of the reference. See column 9-18 for various substituted benzimidazole.

Thus, even if applicants were to overcome the 102 rejection, the genus of compounds of instant claims would be obvious variant of the reference.

In addition, even if the currently presented claims were entered, this rejection will be applicable to those claims.

Hence, this rejection is proper and is maintained.

Claims 1, 3-6 and 12 are rejected under 35 U.S.C. 102 (b) as being anticipated by Barton, EP 0448206.

Barton teaches several benzimidazole compounds, which include instant compounds. See entire document, especially pages 43-44.

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 9/8/2008 prompted the new ground(s) of rejection presented in this Office action.

Allowable Subject Matter

Claim 21(original claim 7) will be allowed, barring finding of any prior art in a subsequent search.

Conclusion

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status

information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Venkataraman Balasubramanian/
Primary Examiner, Art Unit 1624